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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/625,325

07/23/2003

Douglas G. Guenther

WT0115

7745

7590

11/14/2006

Terence P. O'Brien  
Wilson Sporting Goods Co.  
8700 W. Bryn Mawr Avenue  
Chicago, IL 60631

EXAMINER

WONG, STEVEN B

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/625,325	GUENTHER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Steven Wong	3711	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 and 51-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 51-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-3, 5, 7, 9, 10 and 51-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horkan (5,570,882) in view of Martin (4,570,931). Note the basis for the rejections set forth in the Office Actions mailed April 26, 2006
3. Claims 4, 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horkan (5,570,882) in view of Martin (4,570,931) and Feeney (6,283,881). Note the basis for the rejection set forth in the Office Action mailed April 26, 2006.
4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horkan (5,570,882) in view of Martin (4,570,931) and Finley (4,991,842). Note the basis for the rejection set forth in the Office Action mailed April 26, 2006.

***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-14 and 51-64 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 51 and 53-65 of copending Application No. 11/018,628. Although the conflicting claims are not identical, they are not patentably distinct from each other because the projections of 11/018,628 define the pebbled texture as set forth in the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Response to Arguments***

7. Applicant's arguments filed September 16, 2006 have been fully considered but they are not persuasive. Regarding the rejection under 35 U.S.C. 103(a) of the claimed invention over Horkan in view of Martin, the applicant argues that Horkan is directed to a football having laces and a glove with hook and loop fasteners thereon. The applicant states that Horkan does not teach or suggest improving the grip of the ball without the use of the glove. Further, the applicant argues that Horkan implies that only the laces are to include the improved gripping surface and that the rest of the ball must be more slippery and less grippable than the hook and loop material. The applicant then contends that Martin is directed to a basketball with pebbles on its entire outer surface. The applicant argues that there is no suggestion to modify the laces of the football of Horkan which are in one specific location with the pebbles of Martin which are located over the entire surface of a basketball.

However, these arguments are not persuasive as the combination of Horkan in view of Martin is still seen as being properly combined and teaching the instant invention. Horkan

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provides a football construction where the laces are modified in order to improve the gripping ability of the ball. Note column 1, lines 62-67 of Horkan stating that the objectives of the invention are to properly impart spin to a thrown football and improve the user's grasping and controlling of the football. Clearly, these objectives would suggest to one of ordinary skill in the art to look at other arrangements for the laces that also would improve the gripping and controlling of the football by improving the gripping of the laces. The reference to Martin provides such a solution by teaching pebble-like projections on the surface of a basketball that improve its gripping and controlling. Note column 1, lines 18-25 and column 2, lines 30-36 of Martin. These passages disclose that the pebble-like projections improve the gripping of the ball. Thus, contrary to applicant's argument, the reference to Horkan provides a suggestion to modify the laces with the hook/loop fasteners thereon with alternative arrangements that would also improve the gripping and controlling of the football. Martin provides a solution to the suggestion by providing pebble-like projections that are taught as improving the gripping of the basketball.

Regarding Horkan's placement of the loop elements at only the fingertips of the matching glove, this teaching is not seen as teaching away from the combination of Horkan in view of Martin. The placement of the loop elements at only the fingertips of the glove is commensurate with the teachings of Martin as it is well known in the art that it is the user's fingertips which engage the laces of the football for throwing purposes. Just like the engagement between the hook elements on the laces and the loop elements on the fingertips in the invention of Horkan provides a positive feedback so would the engagement between pebbles on the laces and the user's fingertips in the combination of Horkan in view of Martin. The applicant also argues that

without the interaction between the loop and hook elements nothing would urge the user's hands into the proper grasping of the laces. However, this argument is also not persuasive as it is the positive feedback and grasping ability thereof that would occur between the pebbled laces and the user's fingertips that would urge the user's hands into the proper grasping of the laces.

Regarding the applicant's argument that Horkan provides a strong connection between the laces and glove that would not be recreated by the pebble-like projections on the laces, even if this true, it is not seen as precluding the replacement of the hook and loop fasteners with just the pebble-like projections. Replacement of the fasteners with the projections would still accomplish the stated objectives of both references and would provide other advantageous aspects not obtained by the hook and loop fasteners such as the elimination of the glove and the direct grasping of the football on the laces by the user's hand.

Regarding the combination of Horkan in view of Martin and Feeney, the reference to Feeney is relied upon merely for its teaching that it is well known in the art of game balls to provide projections of various shapes.

Regarding the combination of Horkan in view of Martin and Finley, the reference to Finley is relied upon merely for its teaching that it is well known in the art of game balls to randomly place projections on the surface of the ball. The references to Horkan and Martin teach the recited elements of claim 51.

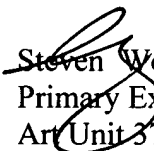
Regarding the affidavit submitted by applicant, the results comparing the coefficients of friction of the various materials have been considered, however, they do not overcome the rejection of Horkan in view of Martin as this combination presents the pebble-like projections on the surface of the laces of the football.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Steven Wong  
Primary Examiner  
Art Unit 3711

SBW  
November 8, 2006